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AUG 13 2002

OFFICE OF PETITIONS

In re Application of
Cappels, et al.
Application No. 09/160,503
Filed: 24 September, 1998
Attorney Docket No.: P2267/1021

ON PETITION

This is a decision on the pleadings filed on 5 March, 2001, and styled "Petition of the Decision on Petition Under 37 C.F.R. §1.181(a)(3)," seeking to overturn the 25 January, 2001, decision of the Group Director, and considered, *inter alia*, under 37 C.F.R. §1.181.¹

Unfortunately, the pleadings were not matched with the file until this writing. The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition under 37 C.F.R. §1.181 to overturn the Group Director's 25 January, 2001, decision (responding to a 30 November, 2000, petition) is **DISMISSED**.

NOTES: (1) The file contains a Notice of Change of Address, however, rather than simply notifying the Office of a relocation, the Notice purports to transfer prosecution authority. For this reason, on 7, 8 and 9 August, 2002, the Office contacted practitioners David Lewis (Mr. Lewis, Reg. No. 33,101) and Nancy Simon (Ms. Simon, Reg. No. 36,930) to request either a withdrawal from the former or a revocation and power of attorney from the latter, which materials each agreed to submit via FAX.

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. ***

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. ***

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. *** (Emphasis supplied.)

As of this writing those materials have not been submitted.

Out of an abundance of caution, the Office is mailing this decision to Mr. Lewis and providing a copy to Ms. Simon. However, both Counsel are cautioned that the appropriate notification must be filed with the Office in this matter, and the Office will not engage in double correspondence. (See: 37 C.F.R. §1.33.²)

- (2) This is the second consideration of issues addressed in the 30 November, 2000, and the 5 March, 2001, petitions, and Petitioner has addressed on appeal issues previously raised here. Therefore, there will be no further reconsideration in this matter on petition.

BACKGROUND

A review of the record reveals:

- the instant application was filed on 24 September, 1998;
- following a restriction requirement (7 January, 2000) and election (7 February, 2000):
 - the Examiner entered a non-final rejection on 17 March, 2000;
 - Petitioner filed an amendment on 14 June, 2000; and
 - the Examiner entered a final rejection on 27 July, 2000, stating therein:

... Claim (sic) 5-10, 12, 25-30, 32, 41-43 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin (pat. # 5,570,108) as applied to claim 4 above, and further in view of Shafer (pat. # 5,386,247).

Continuing, the Examiner first detailed his rejections at pages 7 through 11, and then

² The regulations at 37 C.F.R. §1.334 provide in pertinent part:

§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a registered attorney or agent, or with more than one registered attorney or agent except as deemed necessary by the Commissioner. If more than one correspondence address is specified, the Office will establish one as the correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. * * * (Emphasis supplied.)

responded to Petitioner's arguments at pages 12 through 15;

- on 30 October, 2000, Petitioner filed an after-final amendment, arguing therein, *inter alia*, that the Examiner failed to comply with the commentary at MPEP §707.07(f);³
- a 9 November, 2000, Advisory Action refused entry of the after-final amendment;
- on November 27, 2000, Petitioner sought the intervention of the Group Director, complaining that the Examiner's final rejection:

... did not respond to the Applicants' remarks (filed [14 June, 2000], starting with the paragraph bridging pages 11 and 12 and ending with the paragraph bridging pages 12 and 13) regarding the rejection of claims 5-10, 12, 25-30, 32 and 41-43 over McLaughlin et al. as applied to claim 4 further in view of Shafer, despite the extra emphasis given to these arguments by again referring to them in the summary on page 14 of the response filed [14 June, 2000]. Consequently the Applicants respectfully submit that the Examiner has not complied with MPEP §707 and 707.07(f) and 37 C.F.R. §1.104,^[4] thereby rendering the Office Action

³ The commentary at MPEP§707.07(f) provides:

707.07(f) Answer All Material Traversed

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

ANSWERING ASSERTED ADVANTAGES

After an Office action, the reply (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised. See MPEP § 716 *et seq.* for the treatment of affidavits and declarations under 37 C.F.R. 1.132.

The importance of answering applicant's arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument).

⁴ The regulations at 37 C.F.R. §1.104 provide:

§1.104 Nature of examination.

(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in §1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as

incomplete. It logically follows that an incomplete Office Action cannot properly be made final. The Applicants therefore respectfully request that the finality of the rejection be withdrawn and that either the rejection of the above-identified claims should be withdrawn or the Examiner should explain why he disagrees with the remarks of the Applicant's response of [14 June, 2000].⁵

- in a decision mailed on 25 January, 2001, the Group Director:

-- reminded the Petitioner that the relief sought--i.e., the substantive issue requiring the withdrawal of finality of the 27 July, 2000, Office action--was available only through appeal to the Board of Patent Appeals and Interferences (BPAI), and not through petition to the Commissioner (37 C.F.R. §1.181); and

misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

(5) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter:

(i) Which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration; and

(ii) Which was the same subject matter waived in the statutory invention registration.

(d) Citation of references.

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

(e) Reasons for allowance. If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

[43 Fed. Reg. 20465, May 11, 1978; 46 Fed. Reg. 29182, May 29, 1981; para. (d), 47 Fed. Reg. 41276, Sept. 17, 1982, effective date Oct. 1, 1982; para. (e), 50 Fed. Reg. 9381, Mar. 7, 1985, effective May 8, 1985; para. (e), 57 Fed. Reg. 29642, July 6, 1992, effective Sept. 4, 1992; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c)(4) revised, 65 Fed. Reg. 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 Fed. Reg. 50092, Aug. 16, 2000); paras. (a)(2) and (e) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(5) removed and para. (d)(1) revised, 65 Fed. Reg. 57024, Sept. 20, 2000, effective Nov. 29, 2000]

⁵ Petitioner appears confused between a mail date under a certificate of mail (37 C.F.R. §1.8)--under which a paper/payment is considered timely filed if accompanied by a proper certificate--and a deposit with the US Postal Service Express Mail service (37 C.F.R. §1.10), which is considered the date of filing. While Petitioner repeatedly recites, for example, 12 June, 2000, as the date on which the amendment was "filed," the record clearly evidences that Petitioner's mail dates and dates of filing dates are not the same.

--therefore, denied the relief sought on petition;

- on 5 March, 2001, Petitioner sought review of the Group Director's decision through the instant petition under 37 C.F.R. §1.181.

STATUTES, REGULATIONS AND ANALYSIS

Congress has provided at 35 U.S.C. §(6)(a), in pertinent part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

Why?

Petitioner demands that the Office instruct the Group Director to instruct the Examiner to tell the Petitioner why Petitioner's claims are rejected. No one has answered the question, contends Petitioner, why there was or is maintained a rejection of:

- the substance of "claims 5-10, 12, 25-30, 32 and 41-43 over McLaughlin et al. as applied to claim 4 further in view of Shafer";
- the argument of the 14 June, 2000, amendment; and/or
- the after-final amendment.

The Examiner and the Group Director, says Petitioner, ignore the very rules of the game--i.e, the requirements of 37 C.F.R. §1.104 and §1.113,⁶ and MPEP §707 and §707.07(f)--and won't tell Petitioner why Petitioner is not getting the decision Petitioner wants.

That reported, Petitioner's position is at odds with the record: As noted above at page 2, the Examiner detailed his response to Petitioner's 14 June, 2000, amendment.

⁶ The regulations at 37 C.F.R. §1.113 provide:

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see §1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 Fed. Reg. 10332, Dec. 22, 1959; 46 Fed. Reg. 29182, May 29, 1981; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 Fed. Reg. 50092, Aug. 16, 2000); para. (a) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

Nonetheless, Petitioner was--and remains--unhappy with the bottom line of the Examiner's detailed response. To wit: No!

A review of 35 U.S.C. §(6)(a), 37 C.F.R. §1.104 and §1.113, and MPEP §707 and §707.07(f) reveals that at no place in the statute, regulations or MPEP commentary is there a requirement that the Petitioner be happy with the result. All that is required is that the result be consistent with statute, regulations and policy.

A review of the record does not suggest that either the Examiner failed in this regard, or the Group Director failed to correct such an error on the part of the Examiner.

Rather, the Examiner had to detail his rejections and his reasons, and did so, and the Group Director found that:

- the Examiner's rejections and reasons satisfied statute and regulations, and were consistent with published policy; and
- the relief Petitioner sought was not proper in the premises.

CONCLUSION

For the foregoing reasons, the petition of 5 March, 2001, under 37 C.F.R. §1.181 must be and hereby is **dismissed**.

The instant application is being forwarded to Technology Center 2100 for further processing in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.



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